

Remarks

Favorable reconsideration of this application is requested in view of the following remarks. For the reasons set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The final Office Action dated May 6, 2005, indicated that claims 1-6, 8-16, 21, 23-28, 30, 32-36, 42-49, 51, 53-59, 63-66, 68, 70, and 74 stand rejected under 35 U.S.C. § 102(b) over Hamlin (U.S. Patent No. 5,574,964). Claims 20 and 50 stand rejected under 35 U.S.C. § 103(a) over Hamlin in view of Goldstein (U.S. Patent No. 5,410,326). Claims 7, 22, 29, 31, 37-41, 67, and 75 stand rejected under 35 U.S.C. § 103(a) over Hamlin in view of Edens et al. (U.S. Patent No. 6,611,537). Claims 17-19, 52, and 60-62 stand rejected under 35 U.S.C. § 103(a) over Hamlin in view of Cohen et al. (U.S. Patent No. 4,837,798). Claims 69 and 71-73 stand rejected under 35 U.S.C. § 103(a) over Hamlin in view of Lewis (U.S. Patent No. 5,835,126).

In the Office Action Response filed on July 6, 2005, Applicant respectfully traversed the §§102(b) and 103(a) rejections in the final Office Action for reasons previously presented and for additional reasons provided therein. Applicant maintains the traversals and arguments made in connection with the July 6, 2005 Office Action Response, which are hereby incorporated in these remarks. In the following, certain discussion is directed to the Examiner's Response to Arguments made in connection with the Advisory Action mailed on August 8th, 2005, as applicable to the rejections in the final Office Action.

In the Response to Arguments section of the Advisory Action, the Examiner provided new arguments regarding the Section 103 rejections of claims 11-13. However, these new arguments again fail to address all of the claimed limitations in the context of the components discussed. For instance, beginning with limitations in claim 11 directed to "a data memory circuit coupled to the NIU," the NIU being "adapted to store incoming external services data until a routing command is received from the user input device," the Examiner's reference to a database 48 stops short of teaching or suggesting this claimed functionality. Namely, the Examiner's Response to Arguments discusses the existence of a database 48 but fails to show, among other things, how the database 48 is implemented to "store incoming external services data until a routing command is received." Relevant portions of the '964 reference include the following text, beginning at line 16 of column 4:

A system database storage 48, such as a disk drive, within the system controller 38 holds information on the status of the distribution system 10. The system database 48 stores each frequency of the common bus signal to which an incoming signal has been converted, interface pod address locations, addresses of all receiving locations, and type of receiving unit 46 coupled to each interface pod 44. Essentially, the system database 48 stores all information necessary for the system controller 38 to identify the location of all components of the signal distribution system 12, and to monitor whatever activity is occurring at each location.

In reviewing the above and other portions of the '964 reference, the database storage 48 is not used to store "external services data" as claimed in the instant invention; rather, it appears that the database storage 48 of the '964 reference is limited to storing system-type data characterizing communication frequencies, address locations and equipment types. Referring to FIG. 1 of the '964 reference, it does not appear that any data received via the converter 34 is stored at the database storage 48 at all, much less until a routing command is received from another device (*e.g.*, a receiving unit). The examples on page 4 of the Response to Arguments section of the Advisory Action are directed only to signal routing functions (*i.e.*, routing incoming video signals to a TV or to a VCR) and do not teach or suggest any data storage at the database storage 48. Therefore, the Examiner's assertions of these alleged teachings in the '964 reference are unsupported and contrary to the description therein.

Claims 12 and 13 depend from claim 11; therefore, the rejections of claims 12 and 13 also fail for the reasons stated above. In addition, the Examiner's arguments on pages 4 and 5 of the Advisory Action stop short of showing where the '964 reference teaches the claimed limitations. For example, claim 12 is directed to limitations including a user input device "adapted to communicate with the NIU and determine the type of data that is stored." The Examiner's suggestions, on pages 4 and 5 of the Advisory Action, that a user can utilize stored information and that it is "inherent that the routing information and remote controller could be used to determine the type of data that is stored" are clearly improper for several reasons.

As discussed above, the '964 reference does not store any of the program data received. Rather, the data stored at the system database 48 appears to be limited to information characterizing routing functions. Further, the Examiner has not shown where the '964 reference teaches or suggests that the data stored in the system database 48 is accessible in the context of the Examiner's assertions. The Examiner's misguided attempt to cite support for these

limitations incorrectly alleges (on page 4 of the Advisory Action) that the ‘964 reference teaches “the system controller’s ability to store and maintain format information and allow the user to utilize the information accordingly.” Applicant submits that this cited portion of the ‘964 reference makes no mention of user access to data stored at the system database 48. In this regard, the ‘964 reference does not teach or suggest any “data” types or sources communicated in the context of claims 12 and 13, and does not teach or suggest any such accessible data storage location.

In addition, the Examiner’s assertion that a user can determine the type and source of the signal based upon the frequency that with which the signal is placed on a common bus is unsupported in the cited portion of the ‘964 reference. Specifically, the Examiner cited column 3, lines 30-48 of the ‘964 reference in support of this assertion. Review of this portion of the ‘964 reference reveals no discussion whatsoever of any user (*e.g.*, at a remote controller 42) accessing frequency data stored at the system database 48. Applicant has further reviewed the ‘964 reference in general and cannot ascertain any teaching or suggestion of the user input device being adapted to determine the type of data that is stored at the system database 48.

Furthermore, the Examiner’s assertion on page 5 of the Advisory Action regarding alleged “inherent” teachings of limitations in claims 12 and 13 is unsupported by any evidence and contrary to relevant case law. Specifically, the Examiner has not cited any portion of the ‘964 (or another) reference that suggests using routing information to determine a type of stored data, nor has the Examiner cited any evidence of motivation to modify the ‘964 reference to add such limitations. Relevant case law indicates that such an inherency-type argument, without supporting evidence, is improper. To establish inherency, extrinsic evidence “must make clear that the missing descriptive matter *is necessarily present in the thing described in the reference*, and that it would be so recognized by persons of ordinary skill.” *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991) (emphasis added). “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Id.* at 1269, 20 U.S.P.Q.2d at 1749 (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981)). This case law is consistent with the well-established premise that the Examiner should not be allowed to reconstruct the Applicant’s invention in hindsight, using the invention as the blueprint for crafting such a reconstruction. In this regard, the rejections of claims 12 and

13, which rely upon these improper assertions of inherency, are improper and should be removed.

In view of the above, the Examiner has failed to cite a reference or combination of references that corresponds to Applicant's invention. Therefore, Applicant requests that the §§ 102(b) and 103(a) rejections be withdrawn.


Notwithstanding the above, certain claim amendments have been made. These amendments add no new subject matter and have not been made for reasons of patentability. Applicant submits that the cited references fail to teach or suggest various limitations in the amended claims, as discussed above. Applicant further submits that the cited references fail to teach limitations including, for example in amended claim 1, a memory circuit adapted to store external-services data and configuration data, a programmable NIU and a user input device adapted to access the data stored in the memory circuit and to program the programmable NIU by providing the configuration data.

In view of the above discussion, Applicant believes that the rejection has been overcome and the application is in condition for allowance. A favorable response is requested. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

CRAWFORD MAUNU PLLC
1270 Northland Drive, Suite 390
St. Paul, MN 55120
651/686-6633

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By: 
Eric J. Curtin
Reg. No. 47,511